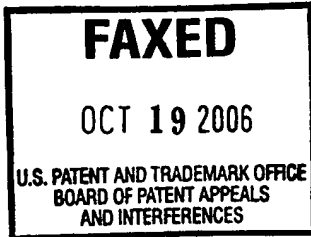


UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES



Ex parte PAUL MILLS

Application No. 09/728,395

CORRECTED ORDER RETURNING UNDOCKED
APPEAL TO EXAMINER

It has come to the attention of the BPAI that in the ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER mailed 10/12/2006 that an incorrect mailing date of the examiner's answer was applied (June 6, 2006). This corrected return corrects the error. All other text remains the same.

This application was received electronically at the Board of Patent Appeals and Interferences on September 22, 2006. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matter requiring attention prior to docketing is identified below:

The Examiner's Answer mailed November 30, 2005 does not list the prior art of record being relied upon in the rejections. Page 3 of the examiner's answer contains a section heading titled **"(8) Evidence Relied Upon"** that states "[n]o evidence is relied upon by the examiner in the rejection of the claims under appeal" beneath it. The Manual Of Patent Examining Procedure (MPEP) § 1207.02(A) (8th ed., Rev. 3, August 2005) defines the above heading as follows:

(8) Evidence Relied Upon. A listing of the evidence relied on (e.g., patents, publications, admitted prior art), and, in the case of nonpatent references, the relevant page or pages.

As per the above, since the examiner's 35 USC § 102(e) rejection is based on the prior art reference to Komiya (U.S. Pat. No. 6,155,025) this reference and any other evidence relied upon in the rejections of the appealed claims should be listed under the **"(8) Evidence Relied Upon"** heading in the examiner's answer. Correction is required.

Accordingly, it is

ORDERED that the application is returned to the Examiner

- a) to issue a revised Examiner's Answer listing the prior art of record being relied upon in the rejection(s) of the appealed claims, and
- b) for such further action as may be appropriate.

Application No. 09/728,395

BOARD OF PATENT APPEALS
AND INTERFERENCES

By: G. P. Eggen for Dale Shaw
DALE M. SHAW
Acting Chief Appeals Administrator
(571) 272-9797

DMS/vsh

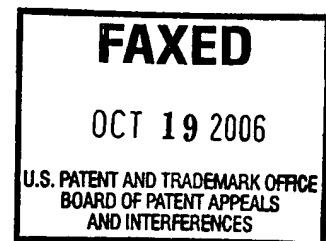
cc: FISH & RICHARDSON PC
P.O. BOX 1022
MINNEAPOLIS MN 55440-1022



**UNITED STATES PATENT AND TRADEMARK OFFICE
Board of Patent Appeals and Interferences (BPAI)
Facsimile Transmission Cover Sheet**

Date: 10/19/2006

To:
Firm: Fish & Richardson, PC
@ Fax#: 617-542-8906



Re: SN 09/728,395
Attrny. Docket No. 11033-063001/A9942US-DJL

From: Vasco Harper (Paralegal (BPAI))
Phone: (571) 272-4615
Facsimile: (571) 273-0300

No of Pages including Transmittal Sheet: 4

Remarks

The Order Returning Undocketed Appeal mailed October 12, 2006 contains an error in the mailing date of the examiner's answer. This fax is being sent as a replacement for the order in error. Please replace the previous return in your records.